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920584-906008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE THE APPLICATION OF)

Eric Lauzon)

Serial No.: 09/606,053)

Filed: June 28, 2000)

For: **CONTROLLING A DESTINATION)
TERMINAL FROM AN ORIGINATING)
TERMINAL**

) Examiner: Ronald D. Harman, Jr.

) Group Art No.: 2121

) Confirmation No.: 5671

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450," on November 4, 2004
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Alexandria, VA 22313-1450

APPELLANTS' BRIEF PURSUANT TO 37 C.F.R. §41.37

In accordance with a Notice of Appeal filed on **September 16**, 2004, the applicants submit this Appellants' brief.

This brief is submitted along with the fee of \$340 for filing of a brief in support of an appeal.

i. Real Party in Interest

All rights to the above referenced patent application have been assigned to:

Nortel Networks Limited
2351 Boulevard Alfred-Nobel
St. Laurent, Quebec H4S 2A9, Canada

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ii. Related Appeals and Interferences

There are no known other appeals or interferences that would directly or indirectly affect the Board's decision in the present appeal.

iii. Status of the Claims

Claims 1 through 24 were originally pending in the application, with claims 12, 13 and 16-24 being withdrawn from consideration. Claims 1-11 and 14-15 are pending, and are the claims that are being appealed.

iv. Status of Amendments

No claim amendments have been filed subsequent to the final rejection. However, a response, without claim amendments, was filed on August 16, 2004 and has been entered.

v. Summary of claimed subject matter

The present invention of the '053 application is concerned with enabling an originating terminal to control a destination terminal. The invention is particularly concerned with the situation where a caller wishes to adapt his or her call as a result of taking the called party's terminal configuration into account.

Using the invention a calling party can select computer software code according to the information it wishes the destination terminal to receive. For example, a calling party may select code enabling their identification by the destination terminal or to give the priority of the call. This information is contained within signalling protocol messages which, for example, are used to set up a session between terminals. Hence, the content of

the code can be taken into account by the destination terminal when the connection is being set up.

The destination terminal, on receiving a signalling protocol message including computer software code can then modify its response to the call according to the information provided within the computer software code and, if appropriate, rules may be set up within the processor. For example, the destination terminal may specify that if a certain person calls with a high priority call then the destination terminal is to be cleared of an “in progress” call.

Therefore the invention also enables calling parties to provide information to the called party and to cause the destination terminal to display or act upon this information.

vi. Grounds of rejection to be reviewed on appeal

There are three grounds of rejection by the Examiner to be reviewed on appeal:

(1) Claims 1-2 and 14-15 have been rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Edwards et al. U.S. Patent No. 6,502,127.

(2) Claims 3-10 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Edwards and further in view of Schuster et al. U.S. Patent No. 6,584,490.

(3) Claim 11 has been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Edwards and further in view of Donovan et al. U.S. Patent No. 6,615,236.

vii Argument

Independent claims 1 and 14 are not anticipated by Edwards under 35 U.S.C. 102 (e).

Edwards is concerned with integrating computer email and telephony systems. It describes a method allowing office workers who are equipped with a telephone and a desktop computer to easily reply to the sender of an email using a telephone.

In Edwards what is disclosed is the embedding of a telephony applet within an email message. For example, in the preferred embodiment described from line 63 column 4 to line 14 column 5 a Java applet is embedded within a document which can then be sent from one Notes user to another by email.

When a user in Edwards receives a document with an applet embedded within it the email client presents an illustrated button to the user, this is shown in Figures 3a to c. The user receiving the email may or may not select the button according to his or her preferences at the time of reading the email. If the button is not selected then the functionality of the applet is not invoked. If the applet is activated by the recipient of the document then the “call request is passed to the JTAPI client, which in turn passes the request onto the JTAPI server 205 on the telephony server 45. This in turn processes the request by passing it onto CTI software 215 on the telephony server, which sends an instruction to the PBX 20 ... to make the desired connection.” (Column 5 lines 40 to 45).

Edwards does not disclose the “associating computer software code with at least one signalling protocol message” as claimed in Claim 1. In Edwards there is provided “an email system which allows telephony applets to be included in email messages” (Abstract). An email message is not the equivalent of a signalling protocol message.

As a matter of law, the term “signaling protocol message” in Claim 1 is to be given the broadest reasonable interpretation, not the broadest possible interpretation. Applicants submit that the term “signaling” is well known in the relevant art and is used

to denote machine-to-machine communication as opposed to human-to-human or human-to-machine communications. “Signaling protocols” are protocols for machine-to-machine communication and thus “signaling protocol messages” are messages exchanged between machines (eg user terminals) for some purpose and are not normally visible to end users. An example of a signaling protocol is Session Initiation Protocol (SIP) . Note that this particular protocol is found within the OSI Seven-Layer protocol model at layer 5. This model describes various layers providing various different functions for machine-to-machine communication. Layer 5 is the “session” layer and includes protocols involved in session management. For example, SIP messages are used to establish, manage and terminate media sessions between user terminals. It is very important to distinguish between the signaling protocol messages (such as SIP messages) and the user messages (such as voice data) which they enable. SIP is responsible for enabling end user communication (by establishing communication sessions between telephony applications, for example), but SIP messages themselves are normally invisible to the end user.

An email message, on the other hand, is a user message which is to be transferred across the network in much the same way that a voice message is transferred across the network during a telephony session. The function of an email message is to communicate information from end user to end user. Thus, an email message is clearly a human-to-human message and not a machine-to-machine message. Thus, on any reasonable interpretation, the term “signaling protocol message” does not include email messages.

In summary, the two message types, signalling protocol and email, can therefore

be seen to fulfill very different functions and one skilled in the art would know that an email is not a type of signalling protocol message.

Applicants submit that Edwards does not disclose “remotely controlling a destination terminal from an originating terminal” nor “executing the computer software code using the processor associated with the destination terminal in order that the software code controls the destination terminal” as claimed in Claim 1. It is unclear in Edwards which is the originating terminal and which is the destination terminal. As the applet is embedded in the email by the sender of the email it might be taken that the sender is at the originating terminal and the receiver of the email is at the destination terminal.

On this assumption (as implicitly proposed by the Examiner), the applet’s functionality is described as being “offered to the recipient of the email message via one or more control button, whereby activation of the relevant button (s) causes the applet to form the requested telephone connection” (Column 3 lines 22 to 25).

Therefore, the recipient of the email, the person at the destination terminal, is given a choice about whether to activate the applet or not. Hence, the destination terminal cannot be said to be being remotely controlled by the email as the final decision as to whether the applet is activated or not and when the applet is activated is taken by a user at the destination terminal. The destination terminal is therefore controlled by its user.

Furthermore, when a user at a destination terminal activates an applet received in an email the “call request is passed to the JTAPI client, which in turn passes the request onto the JTAPI server 205 on the telephony server 45. This in turn processes the request

by passing it onto CTI software 215 on the telephony server, which sends an instruction to the PBX 20 ... to make the desired connection.” (Column 5 lines 40 to 45). The applet is not disclosed as being executed using the processor associated with the destination terminal. Rather it is just passed along until it reaches the PBX where it instructs the PBX to make a connection with the terminal specified in the applet.

Hence, Applicants submit that the computer software code in the applet could only be said to be controlling the PBX of the network as it is the PBX which performs a function when the applet is activated. The PBX is illustrated in Figure 1 as being connected to multiple telephone handsets and desktop computers and, therefore, one skilled in the art would not consider the PBX to be associated with the destination terminal which receives the applet. In view of this Applicants submit that Edwards does not disclose “executing the computer software code using the processor associated with the destination terminal in order that the software code controls the destination terminal”. Instead, Edwards merely passes it on to a third party processor where it is executed.

In light of the above, therefore, the anticipation rejection of Claim 1 with respect to Edwards is respectfully traversed.

Claim 14 recites “a signalling protocol client arranged to receive one or more session initiation protocol (SIP) messages sent from an originating terminal”. As discussed above a signalling protocol message such as SIP is not the equivalent of the email message disclosed in Edwards. Both messages carry out different functions and have different effects within a destination terminal. Hence, Applicants submit that one skilled in the art would not have learnt to have a signalling protocol client arranged to receive one or more session initiation protocol (SIP) messages as claimed in Claim 14,

rather they would only have learnt to have a client for receiving emails.

Claim 14 also recites “a processor arranged to access any computer software code associated with received SIP messages”. As discussed above an email message as disclosed in Edwards is not the equivalent to the SIP messages of the present invention. Therefore, a processor arranged to process an applet which has been embedded within an email message would not be the same as a processor arranged to process computer software code associated with a received SIP message as the two message types serve different functions and are constructed differently.

Furthermore, Claim 14 recites that “said processor is arranged to execute such accessed computer software code such that the destination terminal is controlled”. As discussed above in Edwards, the computer software code acts to control a PBX which is not the equivalent of the destination terminal and could not be considered to form part of the destination terminal as it is connected to many telephones and desktop computers (i.e. many destination terminals).

Thus, Edwards does not disclose any of the features of Claim 14 and hence, the anticipation rejection is respectfully traversed.

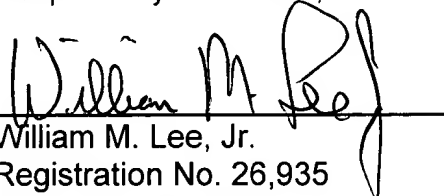
Dependent claims 2-11 and 15 are submitted to be allowable at least by virtue of their dependencies.

CONCLUSION

All pending claims of the application distinguish from and are allowable over the cited references. Reversal of the Examiner and allowance of the application is respectfully requested.

November 3, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William M. Lee, Jr.", is written over a horizontal line.

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viii. Claims Appendix

1. A method of remotely controlling a destination terminal from an originating terminal said destination terminal having an associated signalling protocol client and an associated processor comprising the steps of:
 - (i) associating computer software code with at least one signalling protocol message;
 - (ii) sending the signalling protocol message to the destination terminal from the originating terminal;
 - (iii) executing the computer software code using the processor associated with the destination terminal in order that the software code controls the destination terminal.
2. A method as claimed in claim 1 wherein said step (iii) of executing further comprises activating a security means at the destination terminal and executing the computer software code depending on the activated security means
3. A method as claimed in claim 1 wherein said computer software code is arranged to access information about the identity of the caller.
4. A method as claimed in claim 3 wherein said computer software code is further arranged to display the identity information at the destination terminal.
5. A method as claimed in claim 1 wherein said computer software code is arranged to access information about a priority level for a call associated with the signalling protocol message.
6. A method as claimed in claim 1 wherein said computer software code is arranged to detect whether the destination terminal is engaged, and if so to clear the

destination terminal in order that it is able to accept an incoming call associated with the signalling protocol message.

7. A method as claimed in claim 1 wherein said computer software code is arranged to access information from the destination terminal about the configuration of the destination terminal.
8. A method as claimed in claim 6 wherein said computer software code is further arranged to control the destination terminal on the basis of the accessed configuration information.
9. A method as claimed in claim 1 wherein said computer software code is arranged to modify the configuration of terminating services associated with the destination terminal.
10. A method as claimed in claim 1 wherein said computer software code is arranged to direct a call associated with the signalling protocol message to a voice mail system associated with the called party.
11. A method as claimed in claim 1 wherein said signalling protocol message is a session initiation protocol (SIP) message and wherein said computer software code is selected from: Java byte code, Java applets and mobile automated software agents.
14. A destination terminal comprising:-
 - (i) a signalling protocol client arranged to receive one or more session initiation protocol (SIP) messages sent from an originating terminal;
 - (ii) a processor arranged to access any computer software code associated with received SIP messages in use; and wherein said processor is arranged to execute

such accessed computer software code such that the destination terminal is controlled.

15. A destination terminal as claimed in claim 14 which further comprises stored security information and wherein said processor is arranged to check said security information before executing the accessed computer software code.